UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,293	09/25/2001	Marilyn E. Shade	07844-469001	1631

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EXAMINER
PATEL, MANGLESH M

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/964,293	SHADE ET AL.
	Examiner	Art Unit	
	Manglesh M. Patel	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 September 2001</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-10* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) *1-10* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>08 March 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>6 pg/April 22, 2005</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 7-05)   **Office Action Summary**   Part of Paper No./Mail Date 20050916

DETAILED ACTION

1.   This action is responsive to communications: IDS filed on April 22, 2005 to the

application filed on September 25, 2001.

2.   Claims 1-10 are pending. Claims 1, 5, 9 and 10 are independent claims.

3.   The claim for priority to U.S. Provisional Application Serial No. 60/235,260, filed

on September 25, 2000 has been denied. The U.S. Provisional application is in another

language.

Drawings

4.   The examiner has accepted the Drawings filed on March 8, 2004.

Specification

5.   The specification is objected to because it fails to describe figures 8A, 8B, 10A

and 10B in the brief description of drawings.

Double Patenting

6.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis
added). Thus, the term "same invention," in this context, means an invention drawn to
identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re
Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

7.   Claims 1-3 and 6 are rejected under 35 U.S.C. 101 as claiming the same

invention as that of claims 1-3 of prior U.S. Patent No. 6, 928, 611. This is a double

patenting rejection.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9.   Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Bailey

(U.S. 6,886,133, filed Jun 7, 2001).

Regarding Independent claim 1, Bailey discloses *a text composition spacing*

amount setting device for a desktop publishing (DTP) system, comprising:

- *At least one inter-character-class spacing amount setting table, for use in line*

   composition, for grouping similar characters, forming a plurality of character

   classes and setting inter-character spacing amounts between a character class

   of a previous character and a character class of a next character within a pair of

   continuous characters (column 2, lines 4-15 & column 8, lines 36-43, wherein a

formatting pane displays various formatting properties. The formatting properties

include character spacing properties. In addition the interactive formatting pane

also include table format properties. Therefore a table is used to represent the

character spacing properties);

- *A display device for displaying electronic text that has been line composed*

  (column 2, lines 23-36, wherein a display device is used for formatting stings of

  text. Therefore since each string is subject to formatting properties it includes line

  composition);

- *And an input device for providing user input* (column 4, lines 39-52, wherein a

  user can enter commands through input devices);

- *A spacing amount setter that is operable to display on the display device a dialog*

  box for user input of a spacing amount between the character class for the

  previous character and the character class for the next character, and to display

  in the dialog box an icon representing the character class for the previous

  character and an icon representing the character class for the next character

  (column 8, lines 35-50 & column 6, lines 42-50, wherein a dialog box allows a

  user to control the character spacing properties. In addition Bailey shows the use

  of a icon for adjusting the formatting properties (see figure 3, numeral 320),

  thereby visually distinguishing the various formatting properties for adjusting

  character classes).

Regarding Dependent claim 3, Bailey discloses *a text composition spacing amount setting device, further operable to receive a user selection of either the character class of the previous character or the character class of the next character in the dialog box* (column 8, lines 35-50 wherein a dialog box allows a user to control the character spacing properties, therefore a user can select the various character classes within a dialog box pertaining to character spacing).

Regarding Dependent claim 4, Bailey discloses *wherein a left side display column is provided for icons of the character class for the previous character and a right side display column is provided for icons for the character class of the next character in the dialog box, the device further being operable to display an icon representing a selected character class, among a plurality of classes, for the previous character in the left side display column, and to display an icon representing a selected character class, among a plurality of classes, for the next character in the right side display column* (column 2, lines 4-15 , column 8, lines 35-50 & column 6, lines 42-50, wherein a dialog box allows a user to control the character spacing properties. In addition Bailey shows the use of a icon for adjusting the formatting properties (see figure 3, numeral 320), thereby visually distinguishing the various formatting properties for adjusting character classes. Since table-formatting properties exist it is capable of representing character classes on a right or left side of a column).

Regarding Independent claim 5, Bailey discloses *a computer program product, tangibly stored on a computer-readable medium, for setting at text composition spacing amount in a desktop publishing (DTP) system, comprising instructions operable to cause a programmable processor to:*

- *Display on a display device a spacing amount saved in an inter-class character table in response to a user selection in the inter-character class spacing amount setting table, for use in line composition, the inter-character class spacing amount setting table grouping similar characters, forming a plurality of character classes and defining inter-character spacing amounts between a character class of a previous character and a character class of a next character within a pair of continuous characters* (column 4, lines 39-52 & column 2, lines 4-15 & column 8, lines 36-43, wherein a display device is used for representing a table format within a dialog box for character spacing properties that are adjusted based on user selection, the characters are a continuous pair);

- *And display in the dialog box an icon representing the character class of the previous character and an icon representing the character class of the next character* (column 8, lines 35-50 & column 6, lines 42-50, wherein a dialog box allows a user to control the character spacing properties. In addition Bailey shows the use of a icon for adjusting the formatting properties (see figure 3, numeral 320), thereby visually distinguishing the various formatting properties for adjusting character classes).

Regarding Dependent claim 7, the claim is for a computer program product

performing the steps of claim 3, and is similarly rejected under the same rationale.

Regarding Dependent claim 8, Bailey discloses *a computer program product,*

further operable to:

- *Display a left side display column for icons of the character class of the previous*

  character and a right side display column for icons of the character class of the

  next character in the dialog box (column 2, lines 4-15 & column 8, lines 35-50 &

  column 6, lines 42-50, wherein a dialog box allows a user to control the character

  spacing properties. In addition Bailey shows the use of a icon for adjusting the

  formatting properties (see figure 3, numeral 320), thereby visually distinguishing

  the various formatting properties for adjusting character classes. A table is used

  for representing the formatting properties therefore columns exist for displaying

  the character spacing properties);

- *Display the icon of the selected character class in the left side display column*

  when a character class among a plurality of character classes is selected for the

  previous character's character class (column 2, lines 4-15, column 8, lines 35-50

  & column 6, lines 42-50, wherein a dialog box allows a user to control the

  character spacing properties. In addition Bailey shows the use of a icon for

  adjusting the formatting properties (see figure 3, numeral 320), thereby visually

  distinguishing the various formatting properties for adjusting character classes. A

  table is used for representing the formatting properties therefore columns exist

for either left or right sides of the table for displaying the character spacing

properties);

- *And display the icon of the selected character class in the right side display*

  column when a character class among a plurality of character classes is selected

  for the next character's character class (column 2, lines 4-15, & column 8, lines

  35-50 & column 6, lines 42-50, wherein a dialog box allows a user to control the

  character spacing properties. In addition Bailey shows the use of a icon for

  adjusting the formatting properties (see figure 3, numeral 320), thereby visually

  distinguishing the various formatting properties for adjusting character classes. A

  table is used for representing the formatting properties therefore columns exist

  for displaying the character spacing properties).

Regarding Independent claim 9, Bailey discloses *a text composition spacing*

amount setting device for a DTP system, comprising:

- *At least one inter-character-class spacing amount setting table, for use in line*

  composition, the inter-character-class spacing amount setting table grouping

  similar characters, forming a plurality of character classes and setting inter-

  character spacing amounts between a character class of a previous character

  and a character class of a next character within a pair of continuous characters

  (column 2, lines 4-15, wherein a formatting table is used for representing

  character spacing properties. The characters are grouped based on the

  formatting properties selected by a user);

- *A display means capable of displaying electronic text that has been line composed* (column 2, lines 23-36, wherein a display device is used for formatting stings of text. Therefore since each string is subject to formatting properties it includes line composition);

- *An input means with which a user can perform input* (column 4, lines 39-52, wherein a user can enter commands through input devices);

- *And a spacing amount setting means that is operable to start in response to user input, and to display on the display means a dialog box for user input of spacing amount between the character class of the previous character and the character class of the next character, and to display in the dialog box an icon representing the character class of the previous character and an icon representing the character class of the next character* (column 8, lines 35-50 & column 6, lines 42-50, wherein a dialog box allows a user to control the character spacing properties. In addition Bailey shows the use of a icon for adjusting the formatting properties (see figure 3, numeral 320), thereby visually distinguishing the various formatting properties for adjusting character classes. A dialog box allows a user to control the character spacing properties. Based on the user formatting properties the character spacing would be adjusted for a character class).

Regarding Independent claim 10, Bailey discloses *a computer readable recording medium recording a text composition spacing amount setting program for executing by computer in a desktop publishing system, comprising:*

- *A procedure for displaying on a display means in dialog box format a spacing amount saved in an inter-character-class spacing amount setting table when a user selects the inter-character-class spacing amount setting table, for use in line composition, wherein the inter-character-class spacing amount setting table groups similar characters, forms a plurality of character classes and sets inter-character spacing amounts between a character class of a previous character and a character class of a next character within a pair of continuous characters* (column 2, lines 4-15 & column 8, lines 36-43, wherein a formatting pane displays various formatting properties. The formatting properties include character spacing properties. In addition the interactive formatting pane also include table format properties. Therefore a table is used to represent the character spacing properties that have a relationship with the previous and next character);

- *And a procedure for displaying in the dialog box an icon representing the character class of the previous character and an icon representing the character class of the next character* (column 8, lines 35 & column 6, lines 42-50, wherein a dialog box allows a user to control the character spacing properties. In addition Bailey shows the use of a icon for adjusting the formatting properties (see figure 3, numeral 320), thereby visually distinguishing the various formatting properties for adjusting character classes. A dialog box allows a user to control the character spacing properties. Therefore the previous and the next character are displayed via dialog box for adjusting the spacing properties.).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bailey (U.S. 6,886,133, filed Jun 7, 2001) in view of Sawada (U.S. 5,501,538, filed Jun

21, 1994).

Regarding Dependent claim 2, Bailey teaches the use of a dialog box for accessing a

formatting tool for applying formatting properties. The formatting properties include the

use of character spacing (column 8, lines 35-45). In addition the interactive formatting

pane also include the use of table formatting properties, therefore setting tables for

adjusting character spacing (column 2, lines 4-15). Bailey fails to teach the support for

various character classes for spacing. Sawada teaches *wherein the plurality of*

character classes includes one or more of (1) starting parenthesis, (2) ending

parenthesis, (3) characters that cannot appear at the start of a line, (4) non-centered

punctuation, (5) centered punctuation, (6) period, (7) comma, (8) repeating characters

that cannot be broken across lines, (9) preceding abbreviation code, (10) following

*abbreviation code, (11) full-width ideographic spaces, (12) **hiragana**, (13) Japanese*

characters other than character classes (1) through (12), (14) full-width numeral, (15)

half-width numeral, (16) half-width Roman text, (17) start of line, (18) start of paragraph,

and (19) end of line (column 5, lines 50-56, wherein the character spacing apparatus supports characters from Japanese language including **hiragana** and katakana). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the support for Japanese language characters in a character spacing system. The motivation for doing so would have been to provide a more efficient method of character adjustment for printing purposes by taking the character relationships into account thereby eliminating the use of a skilled operator using kerning techniques. Therefore it would have been obvious to combine the teachings of Sawada with Bailey for the benefits of allowing greater character impression by taking into account the character relationships thereby supporting character spacing for Japanese languages.

Regarding Dependent claim 6, the claim is for a computer program product performing the steps of claim 2, and is similarly rejected under the same rationale.

Other Prior Art Cited

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gillam (U.S. 6,626,960) discloses "Method, System, And Program For Generating A Table To Determine Boundaries Between Characters"
- Babcock et al (U.S. 6,252,607) discloses "Method And System For Character Spacing In Graphics Terminal Emulation"

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.
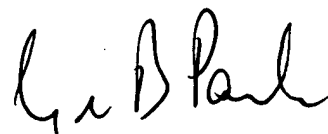
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel

Patent Examiner

September 16, 2005

CESAR PAULA
PRIMARY EXAMINER